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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		09/991,036	20-Nov-2001
		First Named Inventor	
		Richard A. Falk	
		Art Unit	Examiner
		2625	JAMES A. THOMPSON
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 39,862 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Richard A. Falk
Application No. : 09/991,036
Filed : 20 November 2001
For : Spot Color Pattern System
Group Art Unit : 2625
Examiner : JAMES A. THOMPSON

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STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-3, 7, 17-19, 23-26 and 30 are currently pending. Independent claims 1, 17 and 24 have been rejected under 35 U.S.C. § 103(a) as being obvious over Bloomquist U.S. Patent 6,295,133 (“Bloomquist”) in view of Harrington U.S. Patent No. 6,179,485 (“Harrington”) and “obvious engineering design choice.” Applicant respectfully submits that these rejections are clearly erroneous, and that the Examiner has failed to establish a prima facie case of obviousness. Applicant respectfully requests that this Request be granted, and that the Examiner’s rejections be withdrawn.

Brief Description of The Claimed Invention

Independent claims 1, 17 and 24 recite methods, apparatus and corresponding program storage media that: (1) provide a database including a spot color name associated with corresponding image data; (2) receive a print job including PDL code that includes a reference to the spot color name; (3) identify the spot color name in the PDL code; (4) retrieve from the database the corresponding image data associated

with the identified spot color name; (5) add PDL code to the print job for painting the retrieved image data as a PostScript pattern in the print job; (6) execute the PDL code in the print job; and (7) paint the retrieved image data as a PostScript pattern in the print job.

Discussion of Bloomquist

Bloomquist describes a prepress system 32 that includes one or more front end computers 40 connected to a computer network 35. (Col. 6, lines 64-66). The front end computers 40 may output images coded in a page description language (“PDL”) to one or more raster image processors (“RIPs”) 34, which interpret the PDL code and convert the code to raster data. (Col. 7, lines 19-23; Col. 1, lines 52-55). RIPs 34 provide the raster data to print drives 41, which may be used to manipulate the received raster data. (Col. 7, line 67 through Col. 8, lines 11; Col. 11, lines 35-39; Col. 11, line 66 through Col. 12, line 2). In particular, a print drive 41 may combine raster data color separations from one or more images to mask part of an image. (Col. 11, lines 39-49).

For example, a RIP 34 may process an original image to form first raster data 170, which are sent and stored on print drive 41. (Col. 13, lines 34-47). RIP 34 also may process a modification image to form second raster data 176, which are sent and stored on print drive 41. (Col. 13, line 48 through Col. 14, line 20). The modification image contains a modification to the original image and also contains a mask layer, which may be a spot color layer. (Col. 13, lines 56-60). Print drive 41 merges first raster data 172 and second raster data 176 to generate modified raster data 178. (Col. 14, lines 20-23).

Discussion of Obviousness Rejection

The Examiner has agreed that his previous § 103(a) rejections of claims 1, 17 and 24 based solely on Bloomquist were incorrect. Nevertheless, the Examiner has now re-interpreted Bloomquist, and added Harrington and “obvious engineering design choice” in an attempt to fill the void between Bloomquist and the claimed invention. Even under the Examiner’s re-interpretation of Bloomquist, and even with the additional cited reference, the Examiner has failed to establish a prima facie case of obviousness.

As the MPEP states, to establish a prima facie case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations. MPEP 706.02(j). The Office Action fails each of these criteria.

In particular, the prior art references do not teach or suggest all the claim limitations. The Office action primarily relies on Bloomquist, but that reliance is misplaced and erroneous. First, the Office action at 2 states that Bloomquist describes “a database including a spot color layer associated with corresponding image data.” Nothing in the cited portion (Col. 13, lines 56-65; FIG. 11), however describes or suggests anything about a database that includes a spot color name (or even a “spot color layer”) associated with corresponding image data. Bloomquist nowhere describes or suggests that second raster data 176 somehow constitutes a “database” as that term is consistently used in this application and would be understood by a person of ordinary skill in the art.

Second, citing several unrelated references scattered throughout Bloomquist, the Office action at 2 states that Bloomquist describes receiving a print job including PDL code that includes a reference to the spot color layer. None of the scattered citations, however, are related to one another, or describe or suggest anything of the sort. In particular, the first citation (Col. 14, lines 4-15) describes how second raster data 176 and first raster data 170 may be aligned, and how RIP processing time may be reduced. The second citation (Col. 7, lines 51-61) describes network connections that may be used for communicating PDL files from front ends 40 to RIPs 34. The third citation (Col. 13, lines 56-65) states that the modification image includes mask raster data 172 that is a spot color layer created with page composition software. Other than the fact that some of these cited portions contain isolated instances of some of the same words (e.g., “PDL,” “spot color”) used in the claims, the various cited text does not describe or suggest anything about receiving a print job that includes PDL code that includes a reference to anything pertaining to a spot color name (or even a “spot color layer”).

Third, the Office action at 2 states that Bloomquist describes identifying the spot color layer in the PDL code. Once again, the cited portion (Col. 13, line 6 through

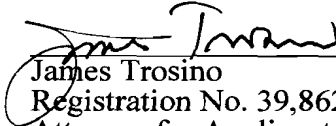
Col. 14, line 3) does not describe or suggest anything of the sort. Instead, the cited portion merely states that “[o]ther techniques of identifying the mask layer can also be used, but the identification needs to fit within the workflow constraints of the prepress environment” Thus, other than including the words “identifying” and “identification,” the cited portion does not describe or suggest anything about identifying a spot color name (or even a “spot color layer”) in PDL code. As in the previous instance, the Examiner action seems to try to support the obviousness rejection based on random portions of Bloomquist that happen to include some words in common with some words in the claims.

Fourth, the Office action at 2 states that Bloomquist describes retrieving from a database corresponding image data associated with the identified spot color layer. Once again, however, the cited portion (Col. 13, lines 56-63 and Col. 14, lines 4-10) does not describe or suggest anything of the sort. Instead, the cited portion describes how second raster data 176 is imposed on a page relative to the placement of first raster data 170. Nothing in this cited portion describes or suggests anything about retrieving anything from a database. Indeed, Bloomquist does not describe anything about retrieving second raster data 176 from a database, and the Office action does not identify any such teaching.

Fifth, the Office action at 2 states that Bloomquist describes adding PDL code to a print job for painting a retrieved image data as a “PDL layer” in the print job. The cited portion (Col. 7, lines 51-59 and Col. 14, lines 9-29), however, does not describe or suggest anything about adding PDL code to a print job. Further, applicants are unaware of the meaning of a “PDL layer,” and the Office action fails to provide any guidance on this seemingly fabricated term. Indeed, the Office action’s subsequent assertion that Bloomquist describes “painting the retrieved (raster) image data as a PDL layer in the print job” is not only nonsensical, but seems to clearly indicate an attempt to force Bloomquist to fit into the language of the claims, regardless of whether such a fit makes any sense.

Applicants should not be required to incur the time and additional expense of preparing and filing an appeal brief, and further prosecuting an appeal of the clearly erroneous rejections in this case. Accordingly, applicants respectfully request that this Request be granted, and that the Examiner's rejections be withdrawn.

Respectfully submitted,


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